

## **R E M A R K S**

### **A. INTRODUCTION**

Claim 1 and 63-76 are pending and rejected.

Upon entry of this Amendment:

- Claims 1 and 63-76 will be pending
- Claims 75 and 76 will be amended without prejudice
- Claims 1, 75 and 76 will be the only independent claims

### **B. REQUEST FOR TELEPHONE INTERVIEW**

Applicants request a Telephone Interview to discuss the claims as amended and the arguments presented in this Reply. The Examiner is encouraged to contact Applicants' representative to schedule a Telephone Interview at his earliest convenience.

### **C. CLAIM AMENDMENTS**

Independent Claim 75 has been amended without prejudice to provide generally for receiving the indication of the purchase via a point-of-sale terminal, in which the second merchant is different than the first merchant, in which the point-of-sale terminal is not owned or controlled by the second merchant, determining, by the central controller, whether a credit account of the customer may be charged the upsell price without exceeding a balance limit of the credit account, and transmitting to the point-of-sale terminal the product identifier for specifying the upsell. No new matter has been added.

Independent Claim 76 has been amended without prejudice to provide generally for receiving the indication of the purchase from a point-of-sale terminal, in which the second merchant is different than the first merchant, in which the point-of-sale terminal is not owned or controlled by the second merchant, determining whether a credit account of the customer may be charged the upsell price without exceeding a balance limit of the credit account, and transmitting to the point-of-sale terminal the product identifier for specifying the upsell. No new matter has been added.

### **D. SECTION 102(B) REJECTION / SECTION 103(A) REJECTIONS**

Claims 1, 63, 65-69 and 72-76 stand rejected under 35 U.S.C. 102(b) as being anticipated by Humble (U.S. Patent No. 4,825,045).

Applicants respectfully traverse the Examiner's Section 102(b) rejection.

Claim 64 stands rejected under 35 U.S.C. 103(a) as being obvious in light of Humble.

Claims 70 and 71 rejected under 35 U.S.C. 103(a) as being obvious in light of Humble and Deaton (U.S. Patent No. 5,621,812)

Applicants respectfully traverse the Examiner's Section 103(a) rejections.

**1. Examiner's Findings**

The Office Action states (enumeration added):

[a] Humble discloses crediting an account based on a coupon, which is an adjustment of a financial account based at least in part on an adjustment value, the value of the coupon being the adjustment value (Humble: col 2, lines 50-65). [b] Crediting a financial account to account for a coupon also implies a debiting of the account for the actual transaction. [c] Humble also discloses performing a comparison to determine whether an account may be debited (Humble: col 3, lines 50-65). Humble teaches comparing product codes to determine whether a product is used in a promotional. In conjunction with the teaching of creating an account based on a coupon, Humble implies performing a comparison to determine whether an account may be debited.

[Office Action, pages 2-3].

The Office Action states (enumeration added):

[d] Humble teaches offering for present purchase a product other than the product actually selected for purchase, which implies an upsell where the purchase price would be increased to match the upsell price and charged to the customer's account (Humble: col 2, lines 50-65).

[Office Action, pages 2-3].

The cited Column 2, lines 50-65 of Humble state:

By way of example of a promotional plan with which the system of FIG. 1 may be used, the invention contemplates various measures of promotion, such as the display of a graphic message relating to the product actually selected for purchase, the display of offers of discount for future purchase of the product actually selected for purchase, the display of offers of discount for present or future purchase of products other than the product actually selected for purchase, the display of offers of general discount coupons for products, offers of a credit to the account of the customer, etc., all for the presentation through display unit 26 upon such discernment of the corresponding UPC code.

The cited Column 3, lines 50-65 of Humble state:

A display unit is provided for receipt of the second circuitry output signals and for presentation of the promotional messages therein.

In its method for the checkout of products bearing sensible codes indicative and for the promotion of related products, the invention provides the steps of storing codes indicative of preselected of the products for use in such promotion, storing for display promotional messages concerning products, detecting sensible codes of purchased products, comparing such detected codes of purchased products with such stored codes, and displaying the stored promotional messages selectively in accordance with the results of such comparison.

## **2. Analysis**

### **2.01. Findings [a] – [d] are not supported by Humble**

Contrary to the finding [a] asserted in the Office Action, Humble does not disclose “crediting an account based on a coupon” at Column 2, lines 50-65, or otherwise in Humble. The cited portion includes an example of promotion of “offers of a credit to the account of the customer,” but unlike all of the other examples, the offer of credit is not described at all with respect to any “coupon.” Accordingly, Humble does not support the finding [a] relied upon in the present Office Action. As it fails to provide substantial evidence in support of the alleged finding [a] of what was known in the art, the Office Action has failed to establish a prima facie case of anticipation with respect to any of independent Claims 1, 75 or 76 (or any of their respective dependent claims).

As Humble does not disclose [a] or “Crediting a financial account to account for a coupon,” Humble cannot “imply” [b] and does not otherwise disclose “a debiting of the account for the actual transaction”. There is no mention in Humble of “the account of the customer” other than in the example promotion discussed above with respect to [a]. Accordingly, contrary to [b], there is no hint in Humble that “the account” is available for debiting for “the actual transaction.” It is not necessary that “the account” in Humble must be used for debiting for the “actual transaction” (the Office Action does not assert otherwise), so such alleged subject matter also is not inherent to Humble. To make a finding that Humble “implies” anything more than that an “account” may be credited based on a promotion offer is to go impermissibly beyond the scope of what Humble actually discloses (explicitly or implicitly). As it fails to provide substantial evidence in support of the alleged finding [b] of what was known in the art, the Office Action has failed to establish a prima facie case of anticipation with respect to any of independent Claims 1, 75 or 76 (or any of their respective dependent claims).

Contrary to the finding [c] asserted in the Office Action, Humble does not disclose “performing a comparison to determine whether an account may be debited” (emphasis added) at Column 3, lines 50-65, or otherwise in Humble. Applicants do agree that Humble discloses “comparing product codes to determine whether a product is used in a promotional.” The cited portion describes determining whether a stored promotional message may be displayed; it does not disclose establishing whether a financial or credit account may be adjusted or charged. Applicants respectfully dispute that “[i]n conjunction with the teaching of creating an account based on a coupon, Humble somehow implies performing a comparison to determine whether an account may be debited.” As discussed above with respect to [a], Humble does not disclose crediting an account based on a coupon, at the cited portion or otherwise. Even if Humble did disclose [a], crediting “the account” does not “imply” determining whether the same account (the only account disclosed in Humble) may be debited.

Finally, contrary to the argument presented in the Office Action, there is no hint in Humble that the comparing of product codes has anything to do with determining whether an account may be debited or eligible for debiting. Only the crediting of an account is disclosed as being related to comparing (e.g., determining whether to present a promotion, which may include crediting the account), and there is no implicit or inherent teaching that would support finding [c]. The finding (and the supporting argument) go well beyond the scope of what is disclosed (explicitly or implicitly) in Humble. Accordingly, Humble does not support the finding [c] relied upon in the present Office Action. As it fails to provide substantial evidence in support of the alleged finding [c] of what was known in the art, the Office Action has failed to establish a prima facie case of anticipation with respect to any of independent Claims 1, 75 or 76 (or any of their respective dependent claims).

Contrary to the finding [d] asserted in the Office Action, Humble does not disclose or imply “an upsell where the purchase price would be increased to match the upsell price and charged to the customer’s account” at Column 2, lines 50-65, or otherwise in Humble. Humble does teach “the display of offers of discount for present or future purchase of products other than the product actually selected for purchase.” However, nothing in that text remotely discloses or “implies” either (i) charging any price to “the account of the customer” (as discussed above with respect to [a]); (ii) increasing a purchase price (for any reason); or (iii) a purchase price increased to match an upsell price. Nothing in the cited portion suggests that such a displayed offer would necessarily, not merely possibly, require the “price matching” proposed by the Examiner; accordingly, the alleged subject matter is not inherent in the cited portion. Accordingly, Humble does not support the finding [d]

relied upon in the present Office Action. As it fails to provide substantial evidence in support of the alleged finding [d] of what was known in the art, the Office Action has failed to establish a prima facie case of anticipation with respect to any of independent Claims 1, 75 or 76 (or any of their respective dependent claims).

**2.02. Humble does not teach *performing, by the central controller, a comparison to establish whether a credit account of the customer may be charged the upsell price***

For at least the reasons stated above with respect to unsupported findings [a] – [c], Applicants submit that Humble does not disclose *performing...a comparison to establish whether a credit account of the customer may be charged the upsell price*, as provided for generally in independent Claim 1.

For at least these reasons, Applicants respectfully submit that the Office Action does not establish a prima facie case of anticipation of Claim 1 (or any dependent claims) by Humble. Further, Applicants submit that Humble does not anticipate Claim 1 because it fails to disclose all of the recited subject matter of Claim 1 much less as claimed in combination.

**2.03. Humble does not teach *charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price***

For at least the reasons stated above with respect to unsupported finding [d], Applicants submit that Humble does not disclose *charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price*, as provided for generally in independent Claims 1, 75 and 76.

Further, the allegedly “implied” teaching that is the subject of finding [d] is for increasing the purchase price to an upsell price. This analysis ignores the plain language of the claimed feature, in which the charged upsell price is *in addition to the purchase price*. For example, in accordance with some embodiments disclosed in the Application, a customer may be charged a purchase price associated with a purchase and *in addition* be charged an upsell price associated with an accepted upsell. Humble does not teach or suggest charging an upsell price in addition to the purchase price, as recited in each of independent Claims 1, 75 and 76.

For at least these reasons, Applicants respectfully submit that the Office Action does not establish a prima facie case of anticipation of any of Claims 1, 75 or 76 (or any dependent claims) by Humble. Further, Applicants submit that Humble does not anticipate Claims 1, 75 or 76 (or any of their respective dependent claims) because it fails to disclose all of the recited subject matter of Claims 1, 75 or 76, much less as claimed in combination.

**2.04. Humble does not teach the combination of features of amended Claims 75 and 76**

Each of Claims 75 and 76 has been amended to provide generally for receiving the indication of the purchase form or via a point-of-sale terminal of the first merchant, and in which the second merchant is not the same as the first merchant and the second merchant does not own or control the point-of-sale terminal. Applicants submit that Humble does not disclose such features.

For at least these reasons, Applicants respectfully submit that the Office Action does not establish a prima facie case of anticipation of Claim 75 or 76 by Humble.

**2.05. Request for Reconsideration of Section 102(b) and Section 103(a) Rejections**

Applicants request reconsideration and withdrawal of the Section 102(b) rejections of Claims 1, 63, 56-69 and 72-76 for at least the reasons stated in this Reply. Applicants also respectfully submit that for at least the reasons set forth with respect to Humble, the Office Action fails to establish a prima facie case of obviousness for any of Claims 64, 70 or 71. In particular, Humble does not support all of the findings for which it is asserted. Applicants request reconsideration and withdrawal of the Section 103(a) rejections of Claims 64, 70 and 71.

**E. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference teaches or the Examiner's interpretation of claimed subject matter or the Specification, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting Claim 1, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**F. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES**

Applicants do not believe that any fees are necessary for this response.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Deposit Account: 50-0271

Order No.: 97-007-C1

Please credit any overpayment to the same account.

**G. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 438-6408 or via electronic mail at [mdowns@finchamdowns.com](mailto:mdowns@finchamdowns.com).

Respectfully submitted,

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